

REMARKS

Status of the Claims

Claims 1-21 are now present in this application. Claims 1, 10, and 18 are independent.

Claims 1, 10-14, and 18 have been amended. Reconsideration of this application, as amended, is respectfully requested.

Reasons for Entry of Amendments

At the outset, it is respectfully requested that this Amendment be entered into the Official File in view of the fact that the amendments to the claims automatically place the application in condition for allowance.

In the alternative, if the Examiner does not agree that this application is in condition for allowance, it is respectfully requested that this Amendment be entered for the purpose of appeal. This Amendment reduces the issues on appeal by placing the claims in compliance with 35 U.S.C. § 101 according to the Examiner's interpretation. Further, the Amendment does not raise any new issues requiring further search and/or consideration.

For example, aside from the inclusion of the term "*non-transitory*" to overcome the § 101 rejection, no new limitations have been added to independent claim 1. Instead, claim 1 has only been amended in order to move the limitation "*wherein said portable recording medium is removable from said processor-based apparatus without powering off said processor-based apparatus*" from the preamble into the body of the claim. Since such limitation had previously been presented to and considered by the Examiner, the aforementioned amendment does not raise any new issues. Thus, the amendment to claim 1 should be entered.

Furthermore, Applicants respectfully submit that claims 10 and 18 have been rewritten in independent form¹ in the above amendments. Such amendments should also be entered since they do not raise any new issues requiring further search and/or consideration. In addition, claims 10-14 have been amended merely in response to an objection by the Examiner. Such

¹ Please note that the apparatus to which claim 10 is directed corresponds to a "*processor-based apparatus*" as recited in claim 1. Thus, in importing the limitations of claim 1 into claim 10, the term "*the apparatus*" has been used instead of "*the processor-based apparatus*." Further, the method of claim 18 is directed to the operation of a "*processor-based apparatus*" as recited in claim 1. Thus, in rewriting claim 18 in independent form, the preamble has been amended to clarify that the method is "*in a processor-based apparatus*."

amendments are merely editorial in nature, and do not raise new issues requiring further search and/or consideration.

Claim Objections

The Examiner objected to claims 10-14 because of the language “recording/reproducing.” Applicants have amended claims 10-14 by replacing the aforementioned language with --recording and reproducing--. In view of this amendment, the Examiner is respectfully requested to reconsider and withdraw the claim objections.

Rejection under 35 U.S.C. § 101

Claims 1-9 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

The Examiner asserts that claim 1 is drawn to a “tangible portable recording medium” is still broad enough to cover transitory propagating signals. Initially, Applicants disagree with this assertion since such transitory propagating signals are not tangible. However, in an effort to expedite prosecution, Applicants have amended claim 1 by replacing the term “tangible” with “non-transitory” as suggested by the Examiner to overcome the rejection.

Applicants respectfully submit that claim 1 currently recites statutory subject matter under 35 U.S.C. § 101. Thus, the Examiner is respectfully requested to reconsider and withdraw this rejection.

Rejection under 35 U.S.C. § 102

Claims 1-8 and 10-21 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yuasa et al. (US 2002/0184457). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

Initially, Applicants respectfully disagree with the Examiner's assertion that the limitation “*wherein said portable recording medium is removable from said processor-based apparatus without powering off said processor-based apparatus*” should not be given patentable weight because it is recited in the preamble. “If the claim preamble, when read in the context of

the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim.” MPEP § 2111.02, *quoting Pitney Bowes, Inc. v. Hewlett-Packard, Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999). The body of claim 1 refers to both “*the portable recording medium*” and “*the processor-based apparatus*.” Thus, the aforementioned limitation in the preamble gives “life, meaning, and vitality” to the remainder of the claim by defining a relationship between the portable recording medium and the processor-based apparatus. Further, the aforementioned preamble limitation does limit the structure of the claimed portable recordable medium by restricting it from having a structure that would require powering off the processor-based apparatus before removal.

However, while Applicants believe that the aforementioned preamble limitation should have been given patentable weight by the Examiner, Applicants have amended independent claim 1 by moving such limitation into the body of the claim. As mentioned above, such amendment does not add any new limitation to the claim and, thus, should be entered.

Accordingly, independent claim 1 clearly requires that the portable recording medium be “*removable from said processor-based apparatus without powering off said processor-based apparatus*.” Furthermore, claim 1 requires that both the “*reproducible information comprising at least one of encoded compressed video information and encoded compressed audio information*” and the “*reservation set command*” to be recorded on the same portable recording medium. Yuasa fails to teach or suggest either of these features.

As can be best understood by Applicants, the Examiner’s rejection relies on Yuasa’s description of the receiving apparatus 1100 to teach both the claimed portable recording medium and the processor based apparatus. However, Applicants submit that none of the components within the receiving apparatus in Yuasa are removable without powering off the receiving apparatus. Instead, it is clear that Yuasa’s receiving apparatus would need to be powered off and disassembled in order to remove the components installed therein such as the storage medium (hard disc) (see Fig. 2). Further, Yuasa’s receiving apparatus does not store reproducible information, which includes encoded compressed video and/or audio information, in the same recording medium as a reservation set command. Instead, Yuasa stores the video/audio content of the recorded programs in the storage medium (hard disc) of accumulation unit 1130 (see

[0098]-[0099]), while any commands/functions for setting a recording reservation in Yuasa would be programmed in the control unit 1140 (see, e.g., [0106]).

Thus, Yuasa fails to teach or suggest the claimed element of a portable recording medium from which information is to be read and processed by a processor-based apparatus, which is removable from the processor-based apparatus without powering off such apparatus. Further, Yuasa does not teach or suggest a portable recording medium on which is recorded both the reproducible information (i.e., encoded compressed video and/or audio information) and the reservation set command, as claimed.

Applicants respectfully submit that Yuasa fails to disclose each and every claimed element of independent claim 1 at least for the reasons explained above. Thus, claim 1 is now in condition for allowance. Further, since the aforementioned claim elements are also included in independent claims 10 and 18, Applicants submit that claims 10 and 18 are likewise allowable. Accordingly, reconsideration and withdrawal of the rejection of claims 1, 10, and 18 are respectfully requested.

With regard to dependent claims 2-8, 11-17, and 19-21 Applicants submit that these claims depend, either directly or indirectly, from independent claim 1 which is allowable as explained above. Therefore claims 2-8, 11-17, and 19-21 are allowable at least by virtue of their dependence from claim 1. Reconsideration and withdrawal of the rejection of these dependent claims are therefore respectfully requested.

Rejections under 35 U.S.C. § 103

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yuasa in view of Mori et al. (US 5,854,873). It is respectfully submitted that Mori does not cure the deficiencies of Yuasa as set forth above in connection with independent claim 1. Instead, Mori is merely cited by the Examiner for alleged teachings of a single-sided dual-layer recording medium comprising a first recording layer and second recording layer (see final Office Action at page 13, 2nd paragraph). Therefore, claim 9 is allowable at least by virtue of its dependence from claim 1.

Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Conclusion

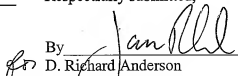
All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Jason W. Rhodes (Registration No. 47305) at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: December 14, 2010

Respectfully submitted,

By  #47,305
D. Richard Anderson
Registration No.: 40439
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road, Suite 100 East
P.O. Box 747
Falls Church, VA 22040-0747
703-205-8000